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Supreme Court of the United States

OCTOBER TERM, 1941

No. 740

WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON,

Petitioners,

vs.

CONWAY P. COE, Commissioner of Patents; AMERICAN TRI-ERGON CORPORATION, TRI-ERGON HOLDING A. G., RADTKE PATENTS CORPORATION and ALBERT A. RADTKE,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

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To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, WHITSON PHOTOPHONE CORPORATION and DELMAR A. WHITSON, respectfully pray for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia to review the judgment of that Court in the above entitled cause. A transcript of the record therein, including the proceedings in said Court of Appeals has been furnished in accordance with the Rules of this Court, in connection with the Petition for Writ of Certiorari filed heretofore by American Tri-Ergon Corporation, et al.

STATEMENT OF CASE

1. Jurisdiction

This Court's jurisdiction is invoked under Section 240 (a) of the Judicial Code (28 U. S. C. A. 347). The date of the judgment, review of which is sought, is June 30, 1941, and the date of denial of rehearing is August 29, 1941.

2. Nature of Suit

This was an action under Revised Statutes 4915 (35 U. S. C. A. 63), filed by the American Tri-Ergon Corporation and Tri-Ergon Holding A. G., hereinafter designated as Vogt, against your petitioners herein, hereinafter designated as Whitson, and Radtke Patents Corporation and Albert A. Radtke, hereinafter designated as Radtke, and Conway P. Coe, Commissioner of Patents. Your petitioners, Whitson, filed an answer and counterclaim and the parties Radtke and Coe filed answers.

Each of the parties Vogt, Whitson, and Radtke alleged substantially in their respective complaints, answers and counterclaims that he was the first and original inventor of the apparatus for which Letters Patent were sought.

3. Subject Matter

The respective applications of the parties for grant of Letters Patent claimed invention of an apparatus to reproduce sound from a sound track or record photographically recorded on film. More specifically the applications of all parties claim the same four counts as set forth in the decision of the Court of Appeals (III R. 2057).

4. Prior Proceedings

Your petitioners Whitson were the first of the parties to file an application for a patent on the subject matter here

involved, on August 20, 1920; the party Vogt filed on April 4, 1921; and the party Radtke on December 27, 1922. Thereafter, from time to time, each of the parties, operating independently and without the knowledge of the others, engaged in controversies with the Patent examiners until in 1927 the Vogt application was rejected on the ground that it did not constitute invention over the prior art, that the prior art anticipated the subject matter (II R. 1619).

(*a*) *Justice Adkins' Decision*:

After such rejection the party Vogt prosecuted an action under R. S. 4915 in the Supreme Court of the District of Columbia in which the Commissioner of Patents was a party. The Commissioner contested the action on the ground that the subject matter of the application was anticipated by the prior art. After trial and after the introduction of evidence by experts and others, Justice Adkins rendered a decision and Findings and Conclusions, specifically holding the subject matter to be invention and therefore patentable. Judgment was rendered thereon authorizing the issuance of a patent to the party Vogt "upon compliance with the requirements of law in such cases made and provided." (II R. 1625).

It is important to note that in this proceeding before Justice Adkins, the People of the United States were represented by the Commissioner of Patents; that through him they took no appeal from said decision and judgment; and that, therefore, the People are bound by that finding and decree that the subject matter was patentable.

(*b*) *Interference Action*:

After the rendition of the judgment and decision by Justice Adkins the Commissioner of Patents declared an interference between the respective applications of the three applicants and directed that they put on their proofs on the

issue of priority. (II R. 1626). Thus, at the commencement of hostilities between the three applicants, their proofs and the issues were limited to priority.

In accordance with the direction of the Patent Office, the parties proceeded to take extensive and voluminous testimony from the Atlantic Sea coast to the Pacific, covering a period of several years, all relating to the issue of priority. On August 17, 1936, (III R. 1963) the Examiner of Interference awarded priority to Radtke which was subsequently affirmed by the Board of Appeals on March 17, 1937, (I R. 28-36) rehearing denied January 22, 1938, (I R. 38-40). The decision of the Examiner related to priority. Nothing was contained therein relating to patentability of the counts. Patent No. 2,114,939 was issued to Radtke as a result.

(*c*) *District Court decision below*:

Thereafter, the party Vogt commenced an action in the District Court for the District of Columbia under R. S. 4915, appealing from the judgments of the Patent Office and the Board of Appeals, in which action Radtke, Whitson and the Commissioner of Patents were named as defendants. Whitson counterclaimed against all of the other parties named therein. The three applicants each alleged (as hereinbefore stated) himself to be the first and original inventor of the subject matter. No issues were tendered or framed on any point but that of priority, the Commissioner contenting himself with seeking his dismissal as not being a proper or necessary party, which was denied to him.

After trial of some five weeks duration, together with the addition of a couple of thousand additional pages of testimony and several dozen more exhibits, to a record of elephantine proportions, Justice Goldsborough rendered his decision (II R. 1510-18), and decree was entered on November 20, 1939, (II R. 1526) based upon Findings and

Conclusions (II R. 1518-1525), authorizing the Commissioner of Patents to issue a patent to Vogt.

Once again it is important to note that this decision of Justice Goldsborough, together with his decree and Findings did not touch or concern patentability, but merely priority, as did the decision of the Examiner of Interferences.

(*d*) *Court of Appeals Decision*:

From this decision of Justice Goldsborough both Radtke and Whitson prosecuted appeals to the Court of Appeals of the District of Columbia. After having the case under submission for more than a year, the Court of Appeals, in an opinion written by Justice Miller and concurred in by Justice Rutledge, (III R. 2056) held that the subject matter did not constitute invention over the art as it existed prior to March 3, 1919, which latter date was the date upon which the party Vogt filed an application in Germany for a patent on the same subject matter, claimed to be the "convention date," and consequently that to none of the contestants were the counts patentable.

Justice Stephens, in a written opinion, dissented from this decision, stating (III R. 2078):

> "I think the decision in this appeal should be upon the question of the correctness of the decree below on the issue of priority and the ancillary issue of disclosure, and that the court should not pass upon the question of patentability."
>
> . . . "Not only was there no issue raised below by either Whitson, Radtke or Vogt as to patentability, but also the Commissioner of Patents made no contention against patentability."

The parties Vogt and Radtke have already filed their petitions herein for writs of certiorari to the said United States Courts of Appeals for the District of Columbia. Whitson by this petition prays for similar relief.

QUESTIONS PRESENTED

1. Was due process of law denied petitioners by a finding of lack of invention by the Court of Appeals of the District of Columbia predicated upon issues not presented in the pleadings and upon which petitioners were afforded no opportunity to produce evidence?

2. Did the Court of Appeals properly make a finding of lack of invention predicated upon scientific treatises later in date than the alleged date of conception and disclosure of petitioners, many of which are not in evidence?

3. Was a finding of lack of invention by the Court of Appeals of three justices, one dissenting, proper where it is contrary to the findings of two Justices of the District Court within the same circuit?

4. Was the Court of Appeals justified in divesting itself of its duties as a reviewing court to protect the public interest where the public is represented by a duly constituted officer, appointed for that purpose?

5. Was the Court of Appeals justified in protecting the public interest where that protection has become moot by reason of the grant of a patent which cannot be recalled?

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT

1. In finding the subject matter unpatentable by consideration of scientific treatises and technical documents, some not in evidence and some published later than petitioners' date of conception and disclosure, without the aid of expert testimony or findings of the trial court supporting such finding, the Court of Appeals has so departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of super-

vision. (Rule 38, 5(b); dissenting opinion III R. 2080; Helis v. Ward, 308 U. S. 365, 370).

2. The Court of Appeals has denied to petitioners their day in Court by deciding matters of scientific fact and opinion which were not presented in the Trial Court and on which petitioners had no opportunity to introduce evidence or to cross examine. (Helis v. Ward, 308 U. S. 365, 370).

3. The Court of Appeals has decided a Federal question in a way probably in conflict with decisions of this Court. (Rule 38; Hill v. Wooster, 132 U. S. 693).

4. The Court of Appeals in a divided opinion reversed a decision by making a finding contrary to the decisions of two District Justices within the District, thus creating a situation where three Justices within the District have held to the contrary. (Robertson & Kirkham, Jurisdiction of the Supreme Court of the United States, p. 618, paragraph 306.) (Morgan v. Daniels, 153 U. S. 120, 125; Mississippi Valley Barge Line Co. v. United States, 292 U. S. 282, 286, 287; Adamson v. Gilliland, 242 U. S. 350, 353; Rule of Civil Procedure, No. 52(a); this Court's Rule 38, 5(b), (c).)

5. The United States Court of Appeals has decided a question of general importance which should be reviewed by this Court. (Rule 38, 5(c); Altoona Publix Theatre Inc. v. American Tri-Ergon Corp., 294 U. S. 477.)

6. The Court of Appeals erroneously applied this Court's decision in Hill v. Wooster, 132 U. S. 693 in considering the question of lack of invention which neither the Commissioner of Patents nor the parties sought to prove and in the face of the patent issued to Radtke.

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Dated, Los Angeles, October 29, 1941.